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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/604,016

06/20/2003

George Pieczenik

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11/17/2005

DR. GEORGE PIECZENIK

APT. 1F

412 EAST 55TH STREET

NEW YORK, NY 10022

EXAMINER

WOOD, AMANDA P

ART UNIT

PAPER NUMBER

1655

DATE MAILED: 11/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/604,016	Applicant(s) PIECZENIK, GEORGE	
	Examiner Amanda P. Wood	Art Unit 1655	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application:
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim 1, drawn to a kit, classified in class 424, subclass 9.1, for example.
- II. Claim 2 drawn to a kit, classified in class 424, subclass 9.1, for example.
- III. Claim 3, drawn to a kit, classified in class 424, subclass 9.1, for example.
- IV. Claim 4, (as defined by the first sentence therein), drawn to a method for identifying compounds for sperm contraception, classified in class 424, subclass 9.1, for example.
- V. Claim 4, (as defined by the second sentence therein), drawn to a method for identifying HIV blocking peptides and using said peptides to block infection of sperm, classified in class 424, subclass 9.1, for example.
- VI. Claim 5, drawn to a method of identifying and developing maturational peptides, classified in class 424, subclass 9.1, for example.
- VII. Claim 6, drawn to a method of identifying ligands, classified in class ***, subclass ***, for example.
- VIII. Claim 7, drawn to a method for genetic disease identification, classified in class 424, subclass 9.1, for example.
- IX. Claim 8, drawn to antagonistic ligands for embryo viability and development, classified in class 424, subclass 9.1, for example.

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- X. Claim 9, drawn to agonistic ligands for embryo viability and development, classified in class 424, subclass 9.1, for example.
- XI. Claim 10 drawn to a reproductive targeting ligand, classified in class 424, subclass 9.1, for example.
- XII. Claims 11-13, drawn to reproductive targeting ligands comprising sperm head ligand and oocyte binding ligand, classified in class 424, subclass 9.1, for example.
- XIII. Claim 14, drawn to a reproductive targeting ligand comprising a bax binding ligand, classified in class 424, subclass 9.1, for example.
- XIV. Claim 15, drawn to an embryological ligand with oncological properties, classified in class 424, subclass 9.1, for example.

The inventions are distinct, each from the other because of the following reasons:

The products of Inventions I-III and IX-XIII are different and distinct, each from the other – i.e., the products of Inventions I-III require a combination of diagnostic products (e.g., ligands) in a kit form whereas the products of Inventions IX-XIII do not require the products (e.g., ligands) to be in a kit form and do not necessarily combine a combination of different ligands. Furthermore, the kits of Inventions I-III are different and distinct, each from the other – i.e., the contents (diagnostics products) of each kit are different and have different functions. In addition, the products of Inventions IX-XIII are different and distinct from one another because each product comprises a different ligand with a different function.

The methods of Inventions IV-VIII are directed to different inventions which are not connected in design, operation, and/or effect. These methods are independent since they are not disclosed as capable of use together, they have different modes of operation, they have different functions, and/or they have different effects. One would not have to practice the various methods at the same time to practice just one method alone. For example, the method of Invention IV is drawn to a method for identifying compounds for sperm contraception, whereas the method of Invention V is drawn to a method for identifying maturational peptides. The methods of each of Inventions IV-VIII are different and distinct, each from the other.

The several inventions above are independent and distinct, each from the other. They have acquired a separate status in the art as a separate subject for inventive effect and require independent searches. The search for each of the above inventions is not co-extensive particularly with regard to the literature search. Further, a reference which would anticipate the invention of one group would not necessarily anticipate or even make obvious another group. Finally, the consideration for patentability is different in each case. Thus, it would be an undue burden to examine all of the above inventions in one application.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement, to be complete, must include an election of the invention to be examined even though the requirement may be traversed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda P. Wood whose telephone number is (571) 272-8141. The examiner can normally be reached on M-F 8:30AM -5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terry McKelvey can be reached on (571) 272-0775. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



A. P. Wood
Examiner
Art Unit 1655

APW



CHRISTOPHER R. TATE
PRIMARY EXAMINER